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09/651,321	08/31/2000	Shawn T Carolan	OPE-112	3901

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Breitt C. Martin  
1650 Tyson Boulevard  
McLean, VA 22102

EXAMINER
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PHILPOTT, JUSTIN M

ART UNIT	PAPER NUMBER
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2665

DATE MAILED: 07/06/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/651,321

Applicant(s)

CAROLAN ET AL.

Examiner

Justin M Philpott

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Priority*

1. Applicant has claimed priority to a series of applications which are continuation-in-part applications (08/971,095 and 08/582,475), one of which is a continuation of 08/529,923 filed September 18, 1995. Applicant is reminded that any claim in a continuation-in-part application which is directed *solely* to subject matter adequately disclosed under 35 U.S.C. 112 in the parent nonprovisional application is entitled to the benefit of the filing date of the parent nonprovisional application. However, if a claim in a continuation-in-part application recites a feature which was not disclosed or adequately supported by a proper disclosure under 35 U.S.C. 112 in the parent nonprovisional application, but which was first introduced or adequately supported in the continuation-in-part application, such a claim is entitled only to the filing date of the continuation-in-part application. See *In re Chu*, 66 F.3d 292, 36 USPQ2d 1089 (Fed. Cir. 1995); *Transco Products, Inc. v. Performance Contracting Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994); *In re Von Lagenhoven*, 458 F.2d 132, 136, 173 USPQ 426, 429 (CCPA 1972); and *Chromalloy American Corp. v. Alloy Surfaces Co., Inc.*, 339 F. Supp. 859, 874, 173 USPQ 295, 306 (D. Del. 1972). Claims 1-29 comprise limitations first introduced in the instant application and accordingly, claims 1-29 are entitled only to the filing date of the instant application, August 31, 2000.

***Information Disclosure Statement***

2. The listing of references in the specification (e.g., page 16, lines 9-12) is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered. Accordingly, the reference of Cormen has not been considered. However, applicant is invited to provide a copy of this reference, in the form of an information disclosure statement.

***Drawings***

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "512" (in FIG. 5) has been used to designate both the E+F connection and the postscript processor. "512" at the E+F connection should be changed to "520" in order to remain consistent with the specification. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "201" (page 14) is not included in FIG. 2. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

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5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: “120j”, “125” and “120k” in FIG. 1; and “256”, “258”, “260” and “262” in FIG. 2. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

#### ***Specification***

6. The disclosure is objected to because of the following informalities: “(OCR). .” (page 2, line 2) should be changed to “(OCR).”. Appropriate correction is required.

#### ***Claim Objections***

7. Claims 5, 11 and 13 are objected to because of the following informalities: “perform a execute” (claim 5, line 2) should be changed to “perform and execute”; “at least one or of cycles” and “perform a execute” (claim 11, line 2) should be changed to “at least one of” and “perform and execute”; and “said leas cost” (claim 13, line 7) should be changed to “said least cost”. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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9. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, claim 1 recites the limitation “the plurality of conversion computing platforms” (lines 8-9). There is insufficient antecedent basis for this limitation in the claim. Claims 2-6 depend upon claim 1 and are therefore rejected for the same reason. Applicant may overcome this rejection by amending claim 1 to instead recite “the plurality of conversion nodes”.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-4, 6-10 and 12-29 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,597,688 to Narasimhan et al.

Regarding claims 1, 7, 13, 18 and 23, Narasimhan teaches a system for converting a file from one data state to another, comprising: a plurality of conversion nodes (e.g., outbound resource 31, see FIG. 2), each node having at least one conversion engine (e.g., processing resources 654, see FIG. 6) executing thereon for converting a file having a one data type to a file having another data state (e.g., see col. 7, lines 30-34 regarding resource 31 being equivalent to server 150, or server 550 of FIGS. 5 and 6, and see col. 11, line 66 – col. 12, line 11 regarding

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processing units of server 550 in FIG. 6 are capable of receiving and transmitting according to a plurality of established protocols including having the capability to digitize voice and other audio data); a least cost conversion processor (e.g., processing server 19, see FIG. 2) to determine a cost associated with each of a plurality of conversion options, the least cost conversion processor determining a least cost (e.g., see col. 3, line 23 – col. 4, line 3; table 8 in col. 6; and col. 7, lines 19-23); and means for transmitting the file to one of the plurality of conversion nodes in accordance with the least cost (e.g., see col. 7, lines 21-23).

Further, regarding claim 23, Narasimhan teaches a cost table (e.g., table 8, see col. 6) contains entries corresponding to the plurality of conversion engines (e.g., processing resources), wherein the cost table comprises static and dynamic cost data (e.g., RESOURCE\_PROVIDER\_RATE; see also col. 7, lines 19-23 wherein resource provider rate, in combination with the other elements of table 8, comprises the total cost in order to determine the “least cost resource”, the total cost inherently comprising static and dynamic cost data) regarding the plurality of conversion engines (e.g., processing resources).

Regarding claims 2 and 8, Narasimhan teaches the plurality of conversion options includes at least one option of having at least one intermediate conversion (e.g., see col. 15, lines 14-32).

Regarding claims 3, 9, 15, 20 and 28, Narasimhan teaches the least cost conversion processor calculates a cost associated with transmitting the file for each of the plurality of conversion options, and uses the calculated cost associated with transmitting the file (e.g., see RESOURCE\_PROVIDER\_RATE in table 8, and see col. 7, lines 19-23).

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Regarding claims 4, 10, 14, 19, 24 and 25, Narasimhan teaches a cost table (e.g., table 8, see col. 6) having stored therein an estimate of static costs and dynamic costs associated with a particular conversion (e.g., see col. 7, lines 19-23 wherein resource provider rate, in combination with the other elements of table 8, comprises the total cost in order to determine the "least cost resource", the total cost inherently comprising static and dynamic cost data).

Regarding claims 6 and 12, Narasimhan teaches the dynamic costs include at least one of current CPU load, memory usage, and file I/O (e.g., RESOURCE\_MAX\_DIGITS, see table 8).

Regarding claims 16, 21 and 27, the creation of a new entry in the cost table (e.g., table 8) of Narasimhan inherently corresponds to an additional conversion engine (e.g., processing resource) added to the system.

Regarding claims 17, 22 and 26, Narasimhan teaches normalizing the costs that are assigned to the one of more conversion engines (e.g., in dollars per second, etc., see table 8).

Regarding claim 29, Narasimhan teaches means for receiving the converted file from the selected conversion engine (e.g., via Receiving Device Type 1-N coupled to resources 31, see FIG. 2).

### ***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.



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13. Claims 5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narasimhan.

Regarding claims 5 and 11, Narasimhan teaches the system discussed above regarding claims 4 and 10, however, Narasimhan may not specifically disclose a static cost includes at least one of cycles required by a CPU to perform and execute a particular conversion engine against a file of a particular size, and the bandwidth required to transmit a particular file.

However, Examiner takes official notice that it is well known in the art that a static cost in a system such as that of Narasimhan includes cycles required by a CPU to perform and execute a particular conversion engine against a file of a particular size. Accordingly, it would have been obvious to one of ordinary skill in the art to include the cycles required by a CPU to perform and execute a particular conversion engine against a file of a particular size in the calculation of the static cost of the total cost calculations in the system of Narasimhan since it is well known in the art that a static cost in a system such as that of Narasimhan includes cycles required by a CPU to perform and execute a particular conversion engine against a file of a particular size.

### ***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 6,134,235 to Goldman et al. discloses a POTS/packet bridge, U.S. Patent No. 6,208,638 to Rieley et al. discloses a method and apparatus for transmission and retrieval of facsimile and audio messages over a circuit or packet switched network, and U.S.

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Patent No. 6,741,608 to Bouis et al. discloses a dynamically configurable system and method for transcoding streaming data.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin M Philpott whose telephone number is 703.305.7357. The examiner can normally be reached on M-F, 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy D Vu can be reached on 703.308.6602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Justin M Philpott



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